

REMARKS

Reconsideration and withdrawal of the requirement for election of species and rejections of the application respectfully requested in view of the amendments, remarks and enclosures herewith, which place the application in condition for allowance.

I. STATUS OF CLAIMS AND FORMAL MATTERS

With the entry of this amendment, claims 1, 8, 13-17 and 22-34 will be pending in this application. The applicants thank the Examiner for acknowledging allowable subject matter if the objections and rejections under 35 U.S.C. §112 were adequately addressed. Old independent claims 1 and 7 have been narrowed as amended claim 1 and new claim 26, respectively. New claims 22-25 are analogous to old claims 2, 3, 5 and 6; new claims 27-30 represent further embodiments of new claim 26; and new claims 31-34 correspond to old claims 9-12 (new claims 31 and 33 are narrower in scope than old claims 9 and 11). No new matter has been added by this amendment.

It is submitted that the claims, herewith and as originally presented, are patentably distinct over the prior art cited in the Office Action, and that these claims were in full compliance with the requirements of 35 U.S.C. § 112. The amendments of the claims, as presented herein, are not made for purposes of patentability within the meaning of 35 U.S.C. §§§§ 101, 102, 103 or 112. Rather, these amendments and additions are made simply for clarification and to round out the scope of protection to which Applicants are entitled.

II. THE OBJECTIONS TO THE CLAIMS HAVE BEEN OVERCOME

- (1) The second occurrence of “is a nitrogen atom” in claim 1 was actually correct as it was referring to “E”. However, the claim has been amended to further clarify this distinction.
- (2) The objection of extraneous phrase “from the” in claim 3 has been rendered moot by the introduction of new claims 27-30.
- (3) The punctuation for old claim 11 has been addressed in new claim 33.
- (4) Old claim 15 has been converted to a method of making a composition.
- (5) The typographical error in claim 16 has been corrected.

III. THE 35 U.S.C. 112, 1st PARAGRAPH REJECTION HAS BEEN OVERCOME

Claims 1-3 and 5-17 were rejected as allegedly failing to describe and enable the scope of the invention claimed. While the applicants disagree with the positions taken by the Examiner, the claims have been amended which narrow the scope of the claims which is believed to render this

rejection moot. The applicants reserve the right to pursue the scope of the originally filed claims in a continuing application.

IV. THE 35 U.S.C. 112, 2nd PARAGRAPH REJECTION HAS BEEN OVERCOME

Claims 1-3 and 5-17 were rejected as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter which the applicants regard as their invention.

- (1) A specific condition associated with the inhibiting adenosine monophosphate deaminase (AMPDA) or adenosine deaminase (ADA) of plants has been added although it is unclear why this is necessary as the inhibition is a definable act and scope of which is determinable by one of ordinary skill in the art.
- (2) With regard to the use of the phrases “Z is a precursor of the radical G-L” and “modifying a compound of the formula (III)” in which Z is a precursor of the radical G-L at the group Z such that the compound (I) is obtained” in claims 8, 9 and 11, the applicants are at a loss as to how to adequately amend these claims while retaining their intended meaning and solicit the Examiner’s assistance in coming up with alternative claim language.

MPEP 707.07(g) states in part “[c]ertain technical rejections (e.g. negative limitations, indefiniteness) should not be made where the examiner, recognizing the limitations of the English language, is not aware of an improved mode of definition.” In addition, MPEP 2173.02 states in part:

*“The examiner’s focus during examination of claims for compliance with the requirement for definiteness of 35 U.S.C. 112, second paragraph is whether the claim meets the threshold requirements of clarity and precision, **not whether more suitable language or modes of expression are available**. When the examiner is satisfied that patentable subject matter is disclosed, and it is apparent to the examiner that the claims are directed to such patentable subject matter, he or she should allow claims which define with a reasonable degree of particularity and distinctness. Some latitude in the manner of expression and the aptness of terms should be permitted even though the claim language is not as precise as the examiner might desire. **Examiners are encouraged to suggest claim language to applicants to improve clarity or precision of the language used, but should not reject claims or insist on their own preferences if other modes of expression selected by applicants satisfy the statutory requirement.**”*

As applied to the phrases used in the claims cited above, the radical G-L is well defined in claim 7 (now claim 26) and one of ordinary skill in the art would be able to determine the scope of moieties for Z that would be able to result in a G-L moiety using conventional modification procedures known in the art to produce the novel compounds of the invention.

- (3) With regard to the terms “cyclizing” and “condensing”, these terms have been deleted as they were superfluous when the term ---reacting--- is present. However, since the starting materials and the end products are defined in the claims and the terms cyclizing (“changing an open-chain hydrocarbon to a closed ring” - from *McGraw-Hill Dictionary of Chemical Terms*, pg. 110, (1984)) and condensing (“one of a class of chemical reactions involving a combination between molecules or between parts of the same molecule”, *Id.* at 100.) have meaning within the chemical arts, it is believed that these terms were sufficiently defined the scope of the invention and the analogy with *Ex parte Porter* to the use of the term “utilizing”, which is more generic term with no particular meaning to those in the chemical arts, did not apply.

V. THE 35 U.S.C. 112, 4th PARAGRAPH REJECTION HAS BEEN OVERCOME

The dependency of claim 7 on claim 1 has been deleted in corresponding claim 26 which should render this rejection moot.

CONCLUSION

In view of the remarks and amendments herewith, the application is believed to be in condition for allowance. Favorable reconsideration of the application and prompt issuance of a Notice of Allowance are earnestly solicited. The undersigned looks forward to hearing favorably from the Examiner at an early date, and, the Examiner is invited to telephonically contact the undersigned to advance prosecution.

Respectfully submitted,
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